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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,125	06/26/2003	Melvin S. Mogil	024643-00015	3648
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ARENT FOX LLP				
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SUITE 400				
WASHINGTON, DC 20036				
EXAMINER				
PASCUA, JES F				
ART UNIT		PAPER NUMBER		
3782				
NOTIFICATION DATE		DELIVERY MODE		
10/13/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com  
IPMatters@arentfox.com  
Patent\_Mail@arentfox.com

### Office Action Summary

**Application No.**

10/606,125

**Applicant(s)**

MOGIL, MELVIN S.

**Examiner**

Jes F. Pascua

**Art Unit**

3782

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/200)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/08/2010 has been entered.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 5-13 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mogil (US 6,234,677) and Preston (US 5,501,338).

Mogil discloses a soft sided insulated container (Fig. 19) having a first portion (504) and a second portion (506) defining first and second enclosed spaces respectively, the second portion being movable between a first folded position (See Fig. 20) and a second unfolded position (See Fig 19), the second portion having at least one releasable securement (534) for maintaining it in the first position, the container having a first closure member to close the first enclosed space, and a second closure member

to control access to the second enclosed space (note zippers), the first and second portions being insulated from each other to permit different environmental conditions to be maintained in the two enclosed spaces, the container further having a third portion mounted thereto defining a third enclosed space (526) wherein an entertainment device is mounted in the third position (the pen in Fig. 15) wherein the assembly has an access port (opening to third portion) capable of accommodating an electrical connection to the entertainment device. Mogil further discloses the second portion having a liner mounted therein, the liner being a monolithic sheet of plastic stock, free of heat welded seams and made of clear plastic the second portion having reflective inner walls visible through the liner (Col. 9, lines 10-25). Mogil discloses all the limitations of the claims except for the first portion further having a substantially rigid, non-collapsible reinforcement member to maintain it in a condition to receive objects in the first enclosed space, the reinforcement member being a receptacle that is substantially the same size and shape of the first portion, defining a chamber within which to receive objects, the reinforcement member being waterproof and operable to contain liquids, the reinforcement member further having a mating divider to partition the first enclosed space into upper and lower and side accommodations, further the receptacle having a horizontal shoulder, and a divider locatable upon the shoulder alternatively the receptacle being a molded plastic bucket. Preston discloses a substantially rigid reinforcement member (10, 12, 14) which is a waterproof plastic receptacle, being a molded plastic bucket (insofar as applicant sets forth the structure of a "bucket", the molded plastic pieces of Preston meet the limitations of the claim) operable to contain liquids and objects, having a mating divider

(32) and a horizontal shoulder (the top of 12 and 14, insofar as applicants claims set forth the structure of a horizontal shoulder), the divider and shoulder working together to partition the first enclosed space into side by side (as in 10, via 34) and upper and lower (12 vs 14 vs 10) regions, in order to keep separate different items stored in the cooler. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to create the assembly of Mogil with the reinforcement member and dividers of Preston in order to create separate regions for different items stored within the cooler. Providing the first portion of Mogil with the reinforcement member of Preston, as discussed above, inherently meets the recitation "said reinforcement member being mounted within said enclosed space; said reinforcement member being mounted within said first portion such that said first portion has a non-collapsible rigid form".

4. Claims 1, 2, 5-11, 16, 17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mogil (US 6,234,677) and Melk (US 5,403,095).

Mogil discloses a soft sided insulated container (Fig. 19) having a first portion (504) and a second portion (506) defining first and second enclosed spaces respectively, the second portion being movable between a first folded position (Fig. 20) and a second unfolded position (Fig. 19), the second portion having at least one releasable securement (534) for maintaining it in the first position, the container having a first closure member to close the first enclosed space, and a second closure member to control access to the second enclosed space (note zippers), the first and second portions being insulated from each other to permit different environmental conditions to

be maintained in the two enclosed spaces, the container further having a third portion mounted thereto defining a third enclosed space (526) wherein an entertainment device is mounted in the third position (the pen in Figure 15) wherein the assembly has an access port (opening to third portion) capable of accommodating an electrical connection to the entertainment device. Mogil further discloses the second portion having a liner mounted therein, the liner being a monolithic sheet of plastic stock, free of heat welded seams and made of clear plastic the second portion having reflective inner walls visible through the liner (Col. 9, lines 10-25). Mogil discloses all the limitations of the claims except for the first portion further having a substantially rigid reinforcement member to maintain it in a condition to receive objects in the first enclosed space, the reinforcement member being a receptacle, being substantially the same size and shape of the first portion, the non-collapsible receptacle being capable of holding liquids, and further being a molded plastic bucket. Melk discloses a substantially rigid reinforcement member (24) comprising a non-collapsible molded plastic bucket (insofar as applicants claims set forth the structure of a "bucket") held inside an analogous insulated portion in order to form a rigid waterproof liner, improving thermal characteristics of the container and providing structural support for the container (Abstract), the reinforcement member being substantially the same size and shape as the insulated portion and giving the insulated portion a non-collapsible, rigid form. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide one of the insulated portions of Mogil with the reinforcement member of Melk, in order to render the insulated portion rigid and waterproof and improve its thermal characteristics and

structural integrity. Providing the first portion of Mogil with the reinforcement member of Melk, as discussed above, inherently meets the recitation "said reinforcement member being mounted within said enclosed space; said reinforcement member being mounted within said first portion such that said first portion has a non-collapsible rigid form".

5. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mogil (US 6,234,677) and Melk (US 5,403,095) as applied to claim 1 above and further in view of Beales (US 5,020,921).

Mogil as modified above discloses all the limitations of the claim except for the reinforcement member having a folding divider for sub-dividing the first enclosed space. Beales discloses a foldable divider for supporting and separating items in an enclosed space (Fig. 4). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the folding divider of Beales in conjunction with the reinforcement member of the modified Mogil container, in order to provide support and separation for the items held within the reinforcement member.

6. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mogil (US 6,234,677) and Preston (US 5,501,338) as applied to claim 2 above and further in view of Arreazola (US 2003/0139169), Sloan (US 6,305,185), Rucker (US 6,216,488) and Ellison (US 5,979,175).

Insofar as Mogil does not disclose the entertainment device requiring a power source, Arreazola, Sloan, Rucker and Ellison disclose the combination of a radio with a

cooler. In light of the teachings of Arreazola, Sloan, Rucker and Ellison, it would have been obvious to one of ordinary skill in the art at the time of invention to insert a standard radio in the third portion of Mogil, and to then provide it power in order to make it operable, as this would allow music to more easily be brought to where the cooler was being used.

7. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mogil (US 6,234,677) and Melk (US 5,403,095) as applied to claim 2 above and further in view of Arreazola (US 2003/0139169), Sloan (US 6,305,185), Rucker (US 6,216,488) and Ellison (US 5,979,175).

Insofar as Mogil does not disclose the entertainment device requiring a power source, Arreazola, Sloan, Rucker and Ellison disclose the combination of a radio with a cooler. In light of the teachings of Arreazola, Sloan, Rucker and Ellison, it would have been obvious to one of ordinary skill in the art at the time of invention to insert a standard radio in the third portion of Mogil, and to then provide it power in order to make it operable, as this would allow music to more easily be brought to where the cooler was being used.

### ***Response to Arguments***

8. Applicant's arguments filed 09/08/2010 have been fully considered but they are not persuasive.



Applicant's primary argument against the applied prior art is that "Mogil clearly teaches away from a rigid container". Applicant remarks "Here, every claim in Mogil is for a collapsible insulated container. It is beyond rational argument, then, that the incorporation of a rigid tub would destroy the collapsible functionality of Mogil's claimed invention. Prima facie grounds for rejection cannot therefore be established on the basis of a combination of either (a) Mogil and Preston; or (b) Mogil and Melk." The Examiner disagrees. It is noted that the non-collapsible members (tray assemblies 12, 14, 16) of Preston are disclosed as being *removable* from its insulated portion (cover 22). See col. 3, lines 18-21. Similarly, the non-collapsible member (liner 24) of Melk is disclosed as being *removable* from its insulated portion (22). Therefore, providing the first portion of the Mogil soft-sided insulated container assembly with the *removable*, non-collapsible members of Preston or Melk, as discussed above, would not interfere with the collapsible functionality of Mogil when the non-collapsible members of Preston or Melk are removed for cleaning.

In response to applicant's argument that "There is no possible room for doubt that Mogil is teaching that both sides of the container are to be collapsible, not rigid. There is, therefore, no room left for a person of ordinary skill in the art to make the interpretation on the Office Action of June 7, 2010 to the contrary", the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of

ordinary skill in the art. In this case, Mogil suggests that it is known in the art of soft-sided insulated container assemblies to contain a removable, stiff member (425, Fig. 14). Preston and Melk each suggest to a person having ordinary skill in the art of soft-sided insulated container assemblies to provide a removable, non-collapsible member/receptacle within an enclosed space defined by a portion of a soft-sided insulated container assembly.

The Examiner maintains that Mogil does not teach away from providing a rigid, non-collapsible reinforcement member by reason of destruction of function. Mogil offers intrinsic evidence of the desirability to provide a substantially rigid, non-collapsible reinforcement member within a collapsible portion having a soft-sided insulated wall structure. Mogil discloses a liner (424) with a removable stiff partition (425) in a horizontal arrangement. See Fig. 14. Mogil further discloses providing at least one of the collapsible portions (502, 504) of the soft-sided insulated container assembly with a liner "provided with an insulated partition analogous to partition 425, as described above in the context of FIGS. 12, 13 and 14". See column 14, lines 4-7. Contrary to applicant's remarks, the removable stiff partition (425) affects, and is relevant to, the collapsibility of the portion (502, 504) containing the partition. A collapsible portion (502, 504) containing the removable stiff partition (425) in a horizontal arrangement (Fig. 14) would be resistant to collapsing along the length and width of the collapsible portion. Mogil discloses the portions (502, 504) to be collapsible (column 13, lines 45-67), yet collapsible portions (502, 504) may contain a removable stiff partition (425) in a horizontal arrangement (column 14, lines 4-7). Mogil neither teaches away the

providing of a rigid, non-collapsible reinforcement member within a collapsible portion nor is the functionality of the Mogil reference destroyed by providing a rigid, non-collapsible reinforcement member within a collapsible portion. Likewise, the functionality of the Mogil reference would not be destroyed by providing one of the collapsible portions of Mogil with the removable, non-collapsible member of Preston or Melk.

In response to applicant's consideration of "the independent claims in detail", applicant cannot show nonobviousness by attacking the Mogil reference individually where the rejections are based on combinations of Mogil and Preston and Mogil and Melk.

Regarding applicant's confusion over the "beverages or food" comment made by the Examiner in the Advisory Action, mailed 09/19/2010, the Examiner was merely trying to make the point that the modifier "collapsible" in the claims of the Mogil reference is a recitation that only requires the insulated container portion to be "capable of" collapsing. In this case, the insulated container portions of the Mogil reference are disclosed as being capable of being collapsed (i.e., collapsible). However, the insulated container portions of the Mogil reference are also disclosed as being filled with food and beverages. When the insulated container portions of the Mogil reference are filled with food and beverages (or contain the removable, rigid, non-collapsible reinforcement member of Preston or Melk, as discussed above), the insulated container portions are still collapsible. The modifier "collapsible" is not a positive limitation but only requires the insulated container portion to have the ability to so perform.

***Conclusion***

9. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the

claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 714.02 and MPEP 2163.06. The "disclosure" includes the claims, the specification and the drawings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jes F. Pascua whose telephone number is 571-272-4546. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Newhouse can be reached on 571-272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jes F. Pascua/

Primary Examiner, Art Unit 3782